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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,194	12/12/2001	Eldad Taub	72524	6362

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EXAMINER

NGUYEN, BINH AN DUC

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

58

Office Action Summary

Application No.

10/017,194

Applicant(s)

TAUB, ELDAD

Examiner

Binh-An D. Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 14-16, 18-20, 22-24, 26-28 and 30-43 is/are rejected.
- 7) ☒ Claim(s) 9, 13, 17, 21, 25 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Request for Continued Examination and the Amendment filed January 25, 2005, respectively, have been received. According to the Amendment, claim 41 has been amended. Currently, claims 1-43 are pending in the application. Acknowledgment has been made.

2. In order to avoid abandonment, the drawing informalities noted in the paper mailed on August 25, 2004, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 10-12, 14-16, 18-20, 22-24, 26-28, and 30-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al. (6,227,850) in view of Fabricant (4,231,181).

Chishti et al. teaches a teeth viewing system, method, or a program having instructions embedded in a storage medium, in which a user, through a user interface, performs one or more tasks within a virtual environment, the system comprising: a

virtual environment having a customized virtual three-dimensional dental image of at least one tooth of the user (2:21-55 and Fig. 5); and said one or more tasks comprise improving a certain virtual condition associated with said at least one tooth; said virtual image comprises a plurality of teeth of at least a continuous section of teeth, substantially all teeth of at least one jaw, substantially all teeth of both the upper and lower jaws; the user can manipulate the mutual orientation of the two jaws; said condition is an inappropriate relative position or orientation of at least one tooth or of a jaw; and said one or more tasks comprise re-orientation of one or more teeth (Figs. 7-17); said one or more tasks are being performed by applying virtual rules, tools or components, corresponding to manner of dental, personal or orthodontic treatment of teeth or jaws; said condition a disorder in or lack of structural integrity of one or more teeth, and said one or more tasks comprise improving or fixing said disorder or lack of structural integrity; virtual rules comprise rules of movements of teeth or jaws corresponding to such in a real-life orthodontic treatment; extracting data from a storage medium, the data being representative of a virtual environment comprising a virtual three-dimensional dental image of at least one tooth of the user, and displaying said virtual environment; and performing, in response to a user command, one or more tasks within a virtual environment to obtain a modified environment and displaying same; storing data representative of said modified environment in a storage medium; repeating said performing step a plurality of times; manipulating, in response to a user command, the relative position or orientation of at least one tooth or of a jaw. See 1:50-20:65 and Figures 1-20. Chishti et al. does not explicitly teach the limitations of the system,

method, or program embedded in a storage medium is for a computer game; virtual tools or components comprise virtual personal mouth hygiene tools (claims 18-20, 40); virtual tools or components are virtual orthodontic components corresponding to real-life orthodontic components (claims 22-24, 40); virtual rules permitting elimination of virtual infectious agents from the virtual teeth (claims 26-28).

Fabricant, however, teaches a dental toy comprising simulated tools or components comprise simulated personal mouth hygiene tools (Fig. 1); simulated tools or components are simulated orthodontic components corresponding to real-life orthodontic components; simulated rules permitting elimination of simulated infectious agents from the simulated teeth (3:24-27). See also, columns 1-4 and Figures 1-7.

Since Chishti et al. teaches a personalized or customized virtual three-dimensional dental image of a user (patient)(2:21-55 and Fig. 5); while Fabricant teaches a dental game having toys simulated personal mouth hygiene tools (Fig. 1), it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine Chishti et al.'s personalized dental images with a simulated dental toy of Fabricant to come up with a personalized virtual dental game to enhance the reality of the game and that would attract more people other than regular game players, thus bring forth more profits from the game.

5. Claims 9, 13, 17, 21, 25, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Applicant's arguments filed January 25, 2005 have been fully considered but they are not persuasive.

Applicant's argument regarding Chishti not teaching the game being customized for the player and used by the player himself or herself (Applicant's remarks, page 17, line 12 to page 18, line 19) is not persuasive. Chishti does teach personalized or customized virtual three-dimensional dental image of a user (patient)(2:21-55 and Fig. 5); and this does not limit the patient from viewing it. Further, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references (Applicant's remarks, page 19, line 20 to page 22, line 11), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Chishti et al. teaches a personalized or customized virtual three-dimensional dental image of a user (patient)(2:21-55 and Fig. 5); while Fabricant teaches a dental game having toys simulated personal mouth

hygiene tools (Fig. 1), hence, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine Chishti et al.'s personalized dental images with a simulated dental toy of Fabricant to come up with a personalized virtual dental game to enhance the reality of the game and that would attract more people other than regular game players, thus bring forth more profits from the game.

Furthermore, applicant's Interview Summary (Applicant's Interview Summary, page 12) is inaccurate. The applicant did not schedule to have an interview with SPE Andrea Wellington. The interview has been scheduled between the examiner and Mr. Lee Heiman, please see the Interview Summary sent October 20, 2004.

7. This is a continuation of applicant's earlier Application No. 10/017194. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

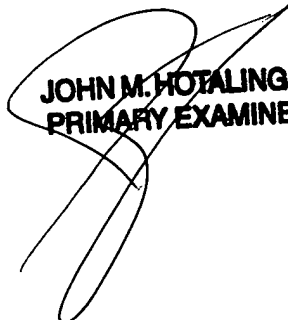
the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BN


JOHN M. HOTALING, II
PRIMARY EXAMINER